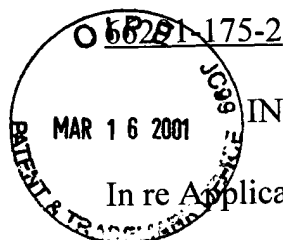


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KEYANS  
5/16/01



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mats LEIJON et al.

Serial No. 09/952,990

Filed: April 9, 1998

) PATENT  
)  
) Group Art Unit: 2834  
)  
) Examiner: E. Enad  
)  
) Client Ref.: 8238  
)

**Rotating Electric Machine Plants**

\* \* \* \* \*

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OFFICE OF PETITIONS

**INFORMATION DISCLOSURE STATEMENT**

Washington, D.C.  
March 16, 2001

Honorable Director of Patents  
Washington, D.C. 20231

Pursuant to 37 C.F.R. §1.56, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO Form-1449. Copies of the references were filed in the office of Examiner Gelner with a petition dated September 27, 1999.

The above information is presented so that the Patent and Trademark Office may, in the first instance, determine any materiality thereof to the claimed invention. See 37 C.F.R. §§1.104(b) concerning the PTO duty to consider and use any such information. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

INFORMATION DISCLOSURE STATEMENT  
U.S. Application No. 09/194,579

Pursuant to the Decision on Petition dated December 1, 1999, which was filed in U.S. Patent Application No. 09/147,325 (the holding application), the requirement for the submission of a copy of each Information Disclosure Statement citation is waived provided that the conditions set forth in paragraphs 1-8 (pages 8-10) of the Decision on Petition are met.

The conditions set forth in the Decision on Petition are believed to have been met as follows:

1. Three paper copies of each Information Disclosure Statement citation were supplied to the U.S. Patent and Trademark Office.
2. This application (the bulk filing application) for which the waiver is desired is related to the above identified holding U.S. Patent Application No. 09/147,325.
3. The information herein has been cited in the above holding application.
4. A copy of the Decision on Petition granting the waiver is attached hereto.
5. At present, no explanatory information related to any particular citation has been submitted in the holding application.
6. As of the time of this filing the office has not terminated the waiver grant, nor has the applicant terminated or withdrawn its assent to the waiver.
7. The holding application is co-pending herewith.

INFORMATION DISCLOSURE CITATION LIST  
ALTERNATE FORM PTO-1019  
(additional to original listing)

Docket Number:

66291/175-2

Application Number

08/952,990

Applicant(s):

MATS LEIJON et al.

Filing Date:

April 9, 1998

Group Art Unit:

2834

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	1	US 1,508,456	9/16/24	W.G.Lenz			
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Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST  
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(Corrected Listing of Original List)

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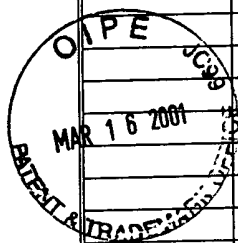
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**INFORMATION DISCLOSURE CITATION LIST  
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**INFORMATION DISCLOSURE CITATION LIST**  
**ALTERNATE FORM PTO-1449**  
 ( Corrected Listing of Original List )

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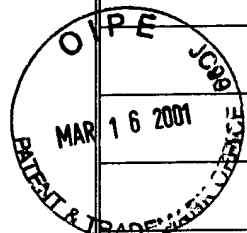
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Examine  
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Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**INFORMATION DISCLOSURE CITATION LIST**  
**ALTERNATE FORM PTO-1449**  
**( Corrected Listing of Original List )**

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GRAND TOTAL	169		
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INFORMATION DISCLOSURE C  
ALTERNATE FORM PTO-

LIST

Docket Number:

66291/175-2

Application Number

08/952,990

Applicant(s):

MATS LEIJON et al.

Filing Date:

April 9, 1998

Group Art Unit:

2834

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	1	US1304451					
	2	US1418856	6/2/22	Robert B. Williamson			
	3	US1481585	1/22/24	James Robert Beard			
	4	US1728915	9/24/29	E. P. Blankenship et al			
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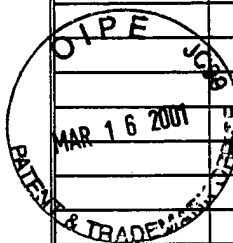
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Subtotal	259						

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		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	1	AT399790	7/25/95	Austria		
	2	BE565063	2/23/57	Belgium		
	3	CH391071	4/30/65	Switzerland		
	4	CH534448	2/28/73	Switzerland		
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176	GB537609	6/30/41	United Kingdom		
177	GB540456	10/17/41	United Kingdom		
178	GB589071	6/11/47	United Kingdom		
179	GB685416	1/7/53	United Kingdom		
180	GB702892		United Kingdom		
181	GB715226	9/8/54	United Kingdom		
182	GB723457	2/9/55	United Kingdom		
183	GB763761	12/19/56	United Kingdom		
184	GB805721	12/10/58	United Kingdom		
185	GB827600	2/10/60	United Kingdom		
186	GB854728	11/23/60	United Kingdom		
187	GB870583	6/14/61	United Kingdom		
188	GB913386	12/19/62	United Kingdom		
189	GB965741	8/6/64	United Kingdom		
190	GB992249	5/19/65	United Kingdom		
191	JP424909	1/28/92	Japan		
192	JP1129737	5/23/89	Japan		
193	JP318253	1/25/91	Japan		
194	JP3245748	2/23/90	Japan		
195	JP4179107	11/9/90	Japan		

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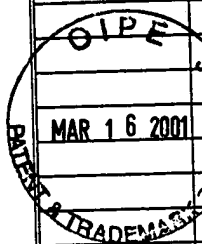
Examiner

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196	JP5290947	4/8/92	Japan
197	JP57043529	8/29/80	Japan
198	JP59076156	10/25/82	Japan
199	JP59159642	2/28/83	Japan
200	JP60206121	3/30/59	Japan
201	JP6196343	12/22/92	Japan
202	JP6233442	2/4/93	Japan
203	JP6264964	9/18/85	Japan
204	JP6325629	5/10/93	Japan
205	JP7057951	8/19/93	Japan
206	JP7264789	3/22/94	Japan
207	JP8167332	12/13/94	Japan
208	JP8264039	11/1/95	Japan
209	JP9200989	1/17/96	Japan
210	LU67199	3/14/72	Luxembourg
211	SE255156	2/25/69	Sweden
212	SE305899	11/11/68	Sweden
213	SE341428	12/27/71	Sweden
214	SE453236	1/20/82	Sweden
215	SE457792	6/12/87	Sweden
216	SE502417	12/29/93	Sweden
217	SE90308	9/21/37	Sweden
218	SU1019553	1/6/80	USSR
219	SU1511810	5/26/87	USSR
220	SU425268	9/27/74	Soviet Union
221	SU694939	1/7/82	Soviet Union
222	SU792302	1/2/71	Soviet Union
223	SU955369	8/30/83	Soviet Union
224	WO8202617	8/5/82	PCT
225	WO8502302	5/23/85	PCT
226	WO9011389	10/4/90	PCT
227	WO9012409	10/18/90	PCT
228	WO9101059	1/24/91	PCT
229	WO9101585	2/7/91	PCT
230	WO9107807	3/30/91	PCT
231	WO9109442	6/27/91	PCT
232	WO8115862	10/17/91	PCT
233	WO9201328	1/23/92	PCT
234	WO9203870		PCT
235	WO9321681	10/28/93	PCT
236	WO9406194	3/17/94	PCT
237	WO9518058	7/6/95	PCT
238	WO9522153	8/17/95	PCT
239	WO9524049	9/8/95	PCT
240	WO9622606	7/25/96	PCT
241	WO9622607		PCT
242	WO9630144	10/3/96	PCT
243	WO9710640	3/20/97	PCT
244	WO9711831	4/3/97	PCT
245	WO9716881	5/9/97	PCT
246	WO9745288	12/4/97	PCT
247	WO9745847	12/4/97	PCT



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300	WO9834244	8/6/98	PCT		
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307	WO9834309	8/6/98	PCT		
308	WO9834312	8/6/98	PCT		
309	WO9834315	0/6/98	PCT		
310	WO9834321	8/6/98	PCT		
311	WO9834322	8/6/98	PCT		
312	WO9834323	8/6/98	PCT		
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319	WO9834331	8/6/98	PCT		
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322	WO9917312	4/8/99	PCT		
323	WO9917313	4/8/99	PCT		
324	WO9917314	4/8/99	PCT		
325	WO9917315	4/8/99	PCT		
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337	WO9919969	4/22/99	PCT		
338	WO9919970	4/22/99	PCT		
339	WO9927546	6/3/99	PCT		
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349	WO9928930	6/10/99	PCT		
350	WO9928931	6/10/99	PCT		
351	WO9928934	6/10/99	PCT		

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352	WO9928994	6/10/99	PCT		
353	WO9929005	6/10/99	PCT		
354	WO9929008	6/10/99	PCT		
355	WO9929011	6/10/99	PCT		
356	WO9929012	6/10/99	PCT		
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360	WO9929016	6/10/99	PCT		
361	WO9929017	6/10/99	PCT		
362	WO9929018	6/10/99	PCT		
363	WO9929019	6/10/99	PCT		
364	WO9929020	6/10/99	PCT		
365	WO9929021	6/10/99	PCT		
366	WO9929022	6/10/99	PCT		
367	WO9929024	6/10/99	PCT		
368	WO9929026	6/10/99	PCT		
369	WO9929029	6/10/99	PCT		
370	WO9929034	6/10/99	PCT		
Subtotal:		370			

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1	OD001	Shipboard Electrical Insulation; G. L. Moses, 1951, pp2&3
2	OD002	ABB El krafthandbok; ABB AB; ; pp274-276
3	OD003	Elkraft teknisk Handbok, 2 Elmaskiner, A. Alfredsson et al; 1988, pp 121-123
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5	OD005	Ohne Tranformator direkt ins Netz; Owman et al, ABB, AB; 2/8/99; pp48-51
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8	OD008	Eine neue Type von Unterwassermotoren; Elektrotechnik und Maschinenbau, 49; 8/1931; pp2-3
9	OD009	Problems in design of the 110-500kV high-voltage generators; Nikiti et al; World Electrotechnical Congress; 6/21-27/77; Section 1. Paper #18
10	OD010	Manufacture and Testing of Roebel bars; P. Marti et al; 1960, Pub.86, Vol 8, pp 25-31
11	OD011	Hydroalternators of 110 to 220 kV Elektrotechn. Obz., Vol. 64, No. 3, pp132-136 March 1975; A. Abramov
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14	OD014	Optimizing designs of water-resistant magnet wire; V. Kuzenev et al; Elektrotehnika, Vol 59, No 12, pp35-40, 1988
15	OD015	Zur Entwicklung der Tauchpumpenmotoren; A. Schanz; KSB, pp19-24
16	OD016	Direct Generation of alternating current at high voltages; R. Parsons; 4/29 IEEE Journal, Vol 67 #393, pp1065-1080
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18	OD018	Zur Geschichte der Brown Boveri-Synchron-Maschinen; Vierzig Jahre Generatorbau; Jan-Feb 1931 pp15-39
19	OD019	Technik und Anwendung moderner Tauchpumpen; A. Heumann
20	OD020	High capacity synchronous generator having no tooth stator, V.S. Kildishev et al; No.1, 1977 pp11-16.
21	OD021	Der Asynchronmotor als Antrieb stopfbuchsloser Pumpen; E. Picmaus; Eletrotechnik und Maschinenbay No. 78, pp153-155, 1961
22	OD022	Low core loss rotating flux transformer; R. F. Krause, et al; American Institute Physics J.Appl.Phys Vol 64 #10 11/1988, pp5376-5378
23	OD023	An EHV bulk Power transmission line Made with Low Loss XLPE Cable; Ichihara et al
24	OD024	Underground Transmission Systems Reference Book
25	OD025	Power System Stability and Control; P. Kundur
26	OD026	Six phase Synchronous Machine with AC and DC Stator Connections, Part II: Harmonic Studies and a proposed Uninterruptible Power Supply Scheme; R. Schiferl et al.
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28	OD028	Reactive Power Compensation; T. Petersson
29	OD029	Different Types of Permanent Magnet Rotors
30	OD030	Permanent Magnet Machines; K. Binns
31	OD031	Hochspannungsanlagen for Wechselstrom; 97. Hochspannungsaufgaben an Generatoren und Motoren; Roth et al; pp452-455
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Subtotal	43	

GRAND  
TOTAL

672

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
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Washington, D.C. 20231

12/13/99  
RESPONSE TO Decision  
2-1-00

Paper No. 11

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**DEC 01 1999**

**SPECIAL PROGRAMS OFFICE  
DAC FOR PATENTS**

Oblon Spivak McClelland Maier & Neustadt  
1755 Jefferson Davis Highway  
Fourth Floor  
Arlington VA 22202

In re Application of  
Mats Leijon, et al  
Application No. 09/147,325  
Filed: February 17, 1999  
Attorney Docket No. 9847-0001-  
6X

: RESPONSE TO PETITION UNDER  
: 37 CFR 1.182 SEEKING SPECIAL  
: TREATMENT RELATING TO AN  
: ELECTRONIC SEARCH TOOL, AND  
: DECISION ON PETITION UNDER  
: 37 CFR 1.183 SEEKING WAIVER  
: OF REQUIREMENTS UNDER 37 CFR  
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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**DEC 03 1999**

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part 1. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule<sup>1</sup>. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.<sup>2</sup> In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

(1)(a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;

(b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition<sup>3</sup> permitting such procedure and a copy of the Form 1449 (or equivalent);<sup>4</sup> and

(2) an "electronic search tool"<sup>5</sup> containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

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<sup>1</sup>Reference to MPEP 2001.05, Petition, page 3.

<sup>2</sup>Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

<sup>3</sup>The original of which would be in the instant holding application.

<sup>4</sup>See, Petition under 37 CFR 1.182, *infra*.

<sup>5</sup>See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.<sup>6</sup>

#### Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

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<sup>6</sup>It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty of disclosure issues under 37 CFR 1.56, Petition, fn. 5. : =

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the \$ 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).<sup>7</sup>

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

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<sup>7</sup>It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). . Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.<sup>8</sup> In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,<sup>9</sup> which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

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<sup>8</sup>The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

<sup>9</sup>Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,<sup>10</sup> on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.<sup>11</sup>

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<sup>10</sup>Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

<sup>11</sup>The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

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preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,<sup>12</sup> or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case with all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

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<sup>12</sup>The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:


By mail: Commissioner of Patents and Trademarks  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Special Program Law Office

By hand: Special Program Law Office  
Crystal Plaza Four, Suite 3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the \$ 1.182 petition re the electronic search tool.



Robert J. Spar  
Director  
Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

Attachment: List of Digests 13-33

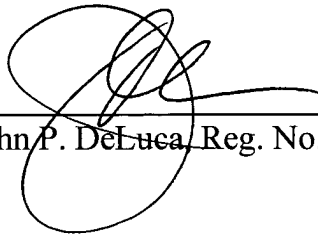
INFORMATION DISCLOSURE STATEMENT  
U.S. Application No. 09/194,579

The paper copies of the references cited herein are believed to be contained in a series of official digests established by the Office which is noted in the Decision On Petition.

You are hereby authorized to charge Deposit Account No. 04-2223 for the statutory fee of \$240. If additional fees are required, please charge Deposit Account No. 04-2223.

Respectfully submitted,

DYKEMA GOSSETT PLLC



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John P. DeLuca, Reg. No. 25,505

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Washington, DC 20005-3306  
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**RECEIVED**

MAR 20 2001

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